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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,988	08/21/2003	Deborah Lynn Carpenter		7496
7590	10/26/2004		EXAMINER	
Pearson & Pearson LLP 10 George Street Lowell, MA 01852			FERNSTROM, KURT	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/644,988	CARPENTER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Kurt Fernstrom	3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 July 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,9-11 and 14-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 21-33 is/are allowed.
- 6) Claim(s) 1-5,9-11 and 14-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-11 and 14-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to an instructional method. While it is understood from the specification that an apparatus is used in the method, claim 9 does not explicitly recite any apparatus as part of the invention. The method steps as recited in claim 9 consist of instructing a child about various rules and such. Such instructional methods are not patentable under 35 USC 101. While processes are one of the four categories of patentable inventions, it does not follow that all processes are therefore patentable.

It is well settled that laws of nature, natural phenomena and abstract ideas are not, by themselves, patentable subject matter. Rather, the test for patentability is whether a useful, concrete and tangible result is achieved. See *Diamond v. Chakrabarty*, 206 USPQ 193 (US SupCt 1980), *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596, (CAFC 1998) and *AT & T Corp. v. Excel Communications Inc.*, 50 USPQ2d 1447 (CAFC 1999). The method of instruction recited in claims 9-11 and 14-20 fails the last two parts of the test. While the instructions given are arguably useful, they do not create a tangible and concrete result,

but rather amount to the manipulation of abstract ideas and therefore are not statutory subject matter.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5, 10, 11 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3-5 are apparatus claims; however, no further limitations to the apparatus are recited. Rather, the claims recite only functional language which describes the intended purpose of the apparatus. The use of the term "optionally" in claims 10 and 11 renders these claims indefinite; it is unclear what, precisely, the scope of the claims is. Similarly, the phrase "varying shapes including a circle or a rectangle in claim 20 is indefinite. It is unclear whether applicant is attempting to recite a Markush group, or certain types of shapes. Also, the use of "including" makes it unclear whether applicant is attempting to restrict the invention to circles and rectangles, or whether other, unmentioned shapes are contemplated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 9-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Makow. The claims are directed to a device for tracking behavior, where positive reinforcement cards and punisher cards are selectively placed on a base panel. Buckley discloses in Figures 1-3 and in column 3, line 41 to column 4, line 34 of the specification a behavior tracking device comprising a base panel 10, on which various tab cards 16 are placed. As described at column 8, lines 1-47, the tab cards include positive reinforcement cards 16b having indicia thereon representing positive reinforcement for performing a favorable act, and consequence cards 16d, which essentially amount to punisher cards and have indicia thereon representing a punishment for performing a favorable act. As described at column 8, lines 42-47 of Buckley, the positive reinforcement cards and the consequence cards are placed on the board 10 and added up to represent a score. Buckley further discloses, in column 9, lines 11-18 and in column 10, lines 8-44 that tangible rewards including play money, toys, candy and so forth may be awarded to the child for positive behavior.

Buckley fails to disclose that positive reinforcement indicia and punishment indicia or provided on the opposite sides of the same card. However, cards having indicia on each side, to be selectively displayed by the user, is known. Makow discloses in Figures 3a and 3b and in column 8, lines 30-42 a device comprising cards 13, where each card has an indicia indicating one concept on one side (devil's fork 13a)

and an indicia for indicating the opposite concept on the other side (halo 13b). It would have been obvious to one of ordinary skill in the relevant art to modify the device of Buckley by providing cards which have “reward” indicia on one side and “punishment” indicia on the other side for the purpose of allowing a user to use a single card to express either of the two concepts.

With respect to claim 2, each card of Buckley attaches to the base panel via pockets. With respect to the language in claims 2-5 and 9, Official Notice is taken that it is well known in educational devices for an instructor to give a user directions on how a teaching device or method works and what the “rules” are. With respect to claims 10 and 11, Official Notice is further taken that it is well known to include children in discussions on matters such as discipline. With respect to claims 19, the limitations recited are considered to be obvious variations on the method of Buckley as viewed in combination with Makow. Because the Buckley device and the present invention have the same function, the use of happy and sad faces on the cards, rather than stars and other indicia, is considered to be an obvious choice of design over the prior art. As a result, the claimed invention is not patentable. With respect to claim 20, Buckley discloses a rectangular card, thus reading on the Markush group of the claim.

***Allowable Subject Matter***

Claims 21-33 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose a device or method having all of the limitations of claims 21 and 28. In particular, the recitation of a plurality of pegs, with a means for attaching a double-sided card as recited to one of the pegs, is not suggested. Because means-plus-function language is used, the claims must be examined under 35 USC 112, ¶ 6, which dictates that such language is to be interpreted in light of the specification. That is, the prior art must disclose or suggest a device which performs substantially the same function as the claimed invention in substantially the same way. In this case, viewing the specification, there is no suggestion in the prior art of a device which performs the claimed function in substantially the same way. Buckley discloses pockets, which are used in a different fashion from the pegs of the present invention. As a result, claims 21 and 28, and all claims dependednt therefrom, are allowed.

### ***Response to Arguments***

Applicant's arguments filed on July 13, 2004 have been fully considered but they are not persuasive. The arguments concerning a "board", and whether Buckley discloses a board, are unpersuasive for several reasons. First, and most importantly, the claims do not recite a board, but rather recite a "base panel". The unit 10 of Buckley is certainly a base panel. Secondly, "board" is a broad term, which would encompass the device of Buckley. Thirdly, the size of a device and whether a device is designed to be portable has no bearing on whether it can be said to be a board. Fourth, foldability has no bearing on whether an object is a board; many commercially available game

boards can be folded. The argument that Buckley does not disclose the attachment of cards to a base unit is also unpersuasive. The pockets 13 of Buckley amount to an attachment means by which the cards 6 are attached to the base unit 10. While the cards of the invention are attached in a different manner than those of Buckley, Buckley nevertheless reads on the pertinent language of claim 1.

Applicant's arguments with respect to the indicia on front and back sides of the car have been considered but are moot in view of the new ground(s) of rejection.

Because new grounds of rejection have been made, this Action is made non-final.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Looney discloses cards having indicia on each side representing opposite concepts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
April 8, 2004



KURT PERNSTROM  
PRIMARY EXAMINER